

IN THE UNITED STATES PATENT OFFICE

In re patent application of:)
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Dean F. Boyer et al.) Before the Examiner
)
) Lindsay M. Maguire
Application No. 09/690,940)
)
) Group Art Unit 3692
Filed: October 18, 2000)
)
) October 6, 2008
POINT OF SERVICE THIRD PARTY)
FINANCIAL MANAGEMENT)
VEHICLE FOR THE HEALTHCARE)
INDUSTRY)
)

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Examiner's Answer issued by the Examiner on August 6, 2008 in connection with the above-indicated application, a Reply Brief according to 37 CFR §41.41 is hereby provided. No fees are believed to be due; however, should any fees be deemed necessary, the Commissioner is authorized to charge any deficiency or credit any overpayment to Deposit Account No. 23-3030, but not to include issue fees.

ARGUMENT

A. Rejections Under 35 U.S.C. §112, first paragraph

The Examiner has maintained her rejection of Claim 92 under 35 U.S.C. §112, first paragraph. The basis for the Examiner's argument is the assertion that the disclosure in Appellant's specification, as originally filed, that "the employer may issue a securitized card" (specification page 17, line 18) is referring to a credit card, and that this does not support the claim recitation "wherein at least a portion of said payment is from a pre-funded account." (Examiner's Answer, page 17, lines 2-13).

Appellants respectfully submit that the Examiner is not aware of the plain meaning of the phrase "securitized card" (or "secured credit card") within the relevant industry to which the invention relates. One of ordinary skill in the art would immediately recognize that "securitized card" means a payment card that is issued to someone who does not have a sufficient credit rating to obtain credit, where the card is secured by a fund of money that has been put on deposit with the card issuer. This is also made very clear by the context in which the phrase is used within the specification, namely "[i]f the patient (employee) is not credit-worthy, the employer may issue a securitized card". In other words, the employer has put a fund of money on deposit to secure the payment card (i.e. it is a pre-funded account).

It is therefore respectfully submitted that claim 92 complies with the written description requirement under 35 U.S.C. §112, first paragraph.

The Examiner further contends (Examiner's Answer, paragraph bridging pages 17-18) that the rejection of claim 93 under 35 U.S.C. §112, first paragraph should be maintained, arguing that the claim terms "first third party payer" and "second third party payer" are not Reply Brief
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supported by the cited section of the specification that specifically states that the adjudication engine allocates “the policy deductible(s), co-pay, co-insurance, and any uncovered amounts” (emphasis added; see specification, page 28, lines 2-4). As is well-known in the insurance art, the term “co-insurance” indicates that the patient has more than one insurance policy that may cover the treatment, therefore indicating that there may be a “first third party payer” and “second third party payer.” The Examiner contends that the recitation in the claim is broader than the disclosure in the specification, since the claim does not require the second third party payer to be co-insurance, and is therefore prohibited by 35 U.S.C. §112, first paragraph. This is not the correct standard under the law.

Notably, the courts have stated that written description is “relatively simple to comply with and thus will ordinarily demand minimal concern on the part of the Patent Office.” *In re Moore*, 169 U.S.P.Q. 236, 238 (CCPA 1971). A prima facie case for this rejection must do more than merely point out a lack of explicit recitation of a claim phrase. *See In re Wright*, 9 U.S.P.Q.2d 1649, 1651 (Fed. Cir. 1989) (that the exact words at issue are not in the specification “is not important”). As with other grounds for rejection, “the examiner has the initial burden of presenting evidence or reasons why persons skilled in the art would not recognize in [the] specification disclosure a description of the invention defined by the claims.” *Ex parte Sorensen*, 3 U.S.P.Q.2d 1462, 1463 (BPAI 1987) (*citing In re Wertheim*, 191 U.S.P.Q. 90 (CCPA 1976)). “To fulfill the written description requirement, the patent specification must describe an invention in sufficient detail that one skilled in the art can clearly conclude that the inventor invented what is claimed.” *Cordis Corp. v. Medtronic AVE Inc.*, 67 USPQ2d 1876, 1885 (Fed. Cir. 2003). However, the disclosure as originally filed does not have to provide in *haec verba* or exact language support for the claimed subject matter at issue. *See, Id.* and *Fujikawa v.*

Wattanasin, 93 F.3d 1559, 1570, 39 USPQ2d 1895 (Fed. Cir. 1996). Rather, as noted in §2163 of the MPEP, “[t]o satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991).” (emphasis added). With respect to broadly claimed inventions, “[a] specification may, within the meaning of 35 U.S.C. §112 para. 1, contain a written description of a broadly claimed invention without describing all species that [the] claim encompasses.” *Utter v. Hiraga*, 845 F.2d 993, 998, 6 USPQ2d 1709 (Fed. Cir. 1988).

Therefore, the fact that Appellants’ claim 93 encompasses more species than are disclosed in the specification is not cause for its rejection. It is therefore respectfully submitted that Appellants’ claim 93 is allowable under 35 U.S.C. §112, first paragraph.

B. Rejections Under 35 U.S.C. §112, second paragraph

The Examiner maintains that the use of the words “approximately” and “substantially” in the claims is improper (Examiner’s Answer, page 18, lines 3-8). The use of words such as “substantially” and “approximately” in claim language has been held to be sufficiently definite to meet the requirements for precision and clarity under 35 U.S.C. §112, second paragraph. “The term ‘substantially’ in this element of the claim is one commonly used in patents to prevent the avoidance of literal infringement by minor changes which do not themselves cause a loss of the benefit of the invention. . . . Indeed, there is authority for the proposition that its presence should always be implied in every claim, even when not introduced. *Musher Foundation, Inc. v. Alba*

Trading Co., Inc., 150 F.2d 885, 889, 66 USPQ 183, 186-87 (2d Cir, 1945).” *National Research Dev. Corp. v. Great Lakes Carbon Corp.*, 188 USPQ 327, 333 (D. Del. 1975). Appellants therefore respectfully submit that claims 48-111 are allowable under 35 U.S.C. §112, second paragraph.

C. Rejections under 35 U.S.C. §103

The Examiner alleges that Barber et al. discloses the use of a credit card at column 4, line 14-18 (Examiner’s Answer, page 19, lines 16-19). Barber merely refers to “[a] card reader 12 reads patient identification cards, physician identification cards, credit cards, and the like.” Therefore, Barber teaches a “patient identification card” that is separate from a payment card or credit card. Barber neither teaches, suggests nor motivates a payment system access card that may be debited to provide reimbursement from a third party.

The Examiner also alleges that, in showing that the PHI references are non-analogous art, “appellant is seeking to set forth additional information without the use of proper affidavits.” (Examiner’s Answer, page 20, lines 8-9). The additional information submitted by Appellants comprises published documents and therefore no affidavits are required, as Appellants are merely making reference to published accounts of the PHI system, exactly as the Examiner has done in her reference to the disclosure about the PHI system in the cited Newswire article.

Similarly, the Examiner alleges that Appellants’ Subsequent Adoption by Others and No Reasonable Expectation of Success arguments (Appeal Brief, page 28) were not considered because they were not supported by affidavits (Examiner’s Answer, page 21, lines 4-8). Again,

Appellants point out that they are relying on published documents as evidence, and therefore no affidavits are required.

Respectfully Submitted:

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